

REMARKS

Claims 2 and 9 were previously canceled. Claims 1, 8, 15 and 17 have been amended. Claims 1, 3-8 and 10-18 remain in the application. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, withdrawal of the final action, and allowance of the application, as amended, is respectfully requested.

Rejection under 35 U.S.C. § 103

Claim 1

Claim 1 recites a method for automatically discovering web services comprising:
querying a known Universal Description Discovery and Integration (UDDI) server address periodically, in a fully automatic fashion without user intervention, by a networked lightweight embedded Consumer Electronics (CE) device via a structured UDDI query, wherein the structured UDDI query includes the use of a unique identity indicative that a web service is technically compliant with a particular web service standard interface which is supported and understood by the networked lightweight embedded CE device, the known UDDI server at the UDDI server address containing a list of web services, and further wherein the list of web services includes one or more service types of distinct web services new to and previously unknown by the networked lightweight embedded CE device (a) that are technically compliant with the particular web service standard interface and (b) which can be used by the networked lightweight embedded CE device to implement at least one of b(i) providing data to the networked lightweight embedded CE device and b(ii) enhancing a functionality of the networked lightweight embedded CE device;

identifying from said list in response to the structured UDDI query the technically compliant distinct web services of one or more service types new to and previously unknown by the networked lightweight embedded CE device,

wherein the identifying is performed at the UDDI server; and
automatically downloading via a structured response from the UDDI server to the networked lightweight embedded CE device at least one machine readable description of a distinct web service from the list of identified technically compliant web services of one or more service types new to and previously unknown by the networked lightweight embedded CE device, wherein the at least one machine readable description enables the networked lightweight embedded CE device to offer a greater choice of web services to a device user.

Support for the amendment to claim 1 (similarly, for claims 8, 15 and 17), can be found in the specification on *at least* page 3, lines 29-30 (*in a fully automatic fashion without user intervention*). As presented, Claim 1 (as well as claims 8, 15 and 17) now more clearly points out and distinctly claims that which is patentable over the art of record.

Claims 1, 3, 6-8, 10, 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US PGPub 2002/0174117 to **Nykanen** (hereafter **Nykanen**) in view of US PGPub 2002/0188589 to **Salmenkaita et al** (hereafter **Salmenkaita**). With respect to claim 1, Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Nykanen** and **Salmenkaita** references cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Nykanen** nor **Salmenkaita** teaches "...querying a known Universal Description Discovery and Integration (UDDI) server address periodically, in a fully automatic fashion without user intervention, by a networked lightweight embedded Consumer Electronics (CE) device via a structured UDDI query ..." as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

In the present case the **Salmenkaita** reference, by providing a context-activity pair to a server *in response to* the user's selection of the activity is directed to a wireless device in which querying the server is not fully automatic without user intervention. In addition, **Salmenkaita** discloses use of a "context-activity pair" in contrast to use of a

unique identity indicative that a web service is technically compliant with a particular web service standard interface which is supported and understood by the networked lightweight embedded CE device. Thus, the system of **Salmenkaita** clearly teaches away from claim 1, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

3. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the **Nykanen** and **Salmenkaita** references cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither **Nykanen** nor **Salmenkaita** teaches, or even suggests, the desirability of the combination since neither teaches the "...**querying** a known Universal Description Discovery and Integration (UDDI) server address periodically, in a **fully automatic fashion without** user intervention, by a networked lightweight embedded

Consumer Electronics (CE) device via a structured UDDI query ... wherein the structured UDDI query includes ... a unique identity indicative that a web service is technically compliant with a particular ... interface ... supported and understood by the networked lightweight embedded CE device ..." as specified above and as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claims 3 and 6-7 depend from and further limit allowable independent claim 1 and therefore are allowable as well.

By this amendment, claim 8 has been amended in a similar manner with respect to the amendments to claim 1. Claim 8 is believed allowable over the **Nykanen** and **Salmenkaita** references for reasons similar as stated herein above with respect to

overcoming the rejection of claim 1. Accordingly, claim 8 is believed allowable and the rejection thereof should be withdrawn. Dependent claims 10 and 13-14 depend from and further limit allowable independent claim 8 and therefore are allowable as well.

Claims 4, 5, 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US PGPub 2002/0174117 to **Nykanen** in view of US PGPub 2002/0188589 to **Salmenkaita** et al as applied respectively to claims 3 and 10 above, and further in view of US PGPub 2003/0061206 to **Qian** (hereafter **Qian**).

With respect to claims 4-5, Applicant respectfully traverses this rejection for at least the following reason. Dependent claims 4-5 depend from and further limit allowable independent claim 1 and therefore are allowable as well.

With respect to claims 11-12, Applicant respectfully traverses this rejection for at least the following reason. Dependent claims 11-12 depend from and further limit allowable independent claim 8 and therefore are allowable as well.

Claim 15

Claim 15 recites a method for automatically discovering TV Anytime web services comprising:

querying a known Universal Description Discovery and Integration (UDDI) server address, in a fully automatic fashion without user intervention, by a networked lightweight embedded Consumer Electronics (CE) device via a structured UDDI query, wherein the structured UDDI query includes the use of a unique identity indicative that a web service is technically compliant with a particular web service standard interface which is supported and understood by

the networked lightweight embedded CE device, the known UDDI server at the UDDI server address containing a list of web services, and further wherein the list of web services includes one or more service types of distinct web services new to and previously unknown by the networked lightweight embedded CE device (a) that are technically compliant with the particular web service standard interface and (b) which can be used by the networked lightweight embedded CE device to implement at least one of b(i) providing data to the networked lightweight embedded CE device and b(i) enhancing a functionality of the networked lightweight embedded CE device;

identifying from said list in response to the structured UDDI query the technically compliant distinct web services of one or more service types new to and previously unknown by the networked lightweight embedded CE device, wherein the identifying is performed at the UDDI server; and

automatically downloading via a structured response from the UDDI server to the networked lightweight embedded CE device at least one machine readable description of a distinct web service from the list of identified technically compliant web services of one or more service types new to and previously unknown by the networked lightweight embedded CE device, wherein the at least one machine readable description enables the networked lightweight embedded CE device to offer a greater choice of web services to a device user, wherein further said querying comprises transmitting the structured query in a predefined format, and said structured query further including an element specifying a set of taxonomies to which said identified compliant web service must conform.

Claims 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US PGPub 2002/0174117 to **Nykanen** in view of US PGPub 2002/0188589 to **Salmenkaita** in view of US PGPub 2003/0061206 to **Qian**.

With respect to claim 15, Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, a prima facie case of obviousness has not been factually supported for the at least the following reason.

Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Nykanen**, **Salmenkaita** and **Qian** references cannot be applied to reject claim 15 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. Neither **Nykanen**, **Salmenkaita** and **Qian** references teaches "... querying a known Universal Description Discovery and Integration (UDDI) server address periodically, in a fully automatic fashion without user intervention, by a networked lightweight embedded Consumer Electronics (CE) device via a structured UDDI query ..." as is claimed in claim 15.

Therefore, it is impossible to render the subject matter of claim 15 as a whole obvious, and the explicit terms of the statute cannot be met. The rejection under 35 U.S.C. §103 should be withdrawn. Accordingly, claim 15 is allowable and an early formal

notice thereof is requested.

Dependent claim 16 depends from and further limits allowable independent claim 15 and therefore is allowable as well.

By this amendment, claim 17 has been amended in a similar manner with respect to the amendments to claim 15. Claim 17 is believed allowable over the **Nykanen, Salmenkaita** and **Qian** references for reasons similar as stated herein above with respect to overcoming the rejection of claim 15. Accordingly, claim 17 is believed allowable and the rejection thereof should be withdrawn.

Dependent claim 18 depends from and further limits allowable independent claim 17 and therefore is allowable as well.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 8, 15 and 17 are in condition for allowance. Dependent claims 3-7 depend from and further limit independent claim 1, and therefore are allowable as well. Dependent claims 10-14 depend from and further limit independent claim 8, and therefore are allowable as well. Dependent claim 16 depends from and further limits independent claim 15, and therefore is allowable as well. In addition, dependent claim 18 depends from and further

limits independent claim 17, and therefore is allowable as well. The amendments herein are fully supported by the original specification and drawings as discussed herein; therefore, no new matter is introduced.

Withdrawal of the final action and issuance of an early formal notice of allowance of claims 1, 3-8 and 10-18 is respectfully requested.

Respectfully submitted,

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